Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JIAJIU SHAW

Appeal No. 2003-0631
Application 09/580,232

ON BRIEF

Before SCHEINER, MILLS, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 6. We note that on page 3 of Paper No. 4, the examiner has indicated that claims 7 through 19 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1 is representative of the subject matter on appeal and is set forth below:

1. A delivery system comprising the following:

A main compartment confined by a pharmaceutically acceptable membrane, with the inside of the main compartment comprising (a) a pharmaceutical composition, and (b) one or a plurality of sub-compartments confined by membrane, which is porous or becomes porous upon contacting aqueous environment, with the inside of the sub-compartment or sub-compartments comprising a pharmaceutical composition, wherein the main compartment and the sub-compartment or compartments are independent of each other.

The examiner relies on the following reference as evidence of unpatentability:

Faour et al. (Faour)	6,004,582	Dec. 21, 1999 (filed May 29, 1998)

Claims 1 through 6 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Faour.

Claims 1 through 6 also stand rejected under 35 U.S.C. § 103 as being obvious over Faour.

OPINION

We reverse each of the rejections made by the examiner for the following reasons.

Appellant's arguments are summarized as follows. Appellant argues that Faour does not teach or suggest a compartment within a compartment. Brief, pages 6-7. Appellant argues that Faour does not teach or suggest at least two pharmaceutical compositions on the inside of the outermost membrane of the device. Brief, pages 7-9. Appellant also argues that Faour does not teach or suggest at least two compartment-confining

membranes, and does not teach or suggest a main compartment and a sub-compartment that are independent of each other. Brief, pages 8-10. Appellant further argues that Faour does not describe the delivery systems of the instant claims on appeal. Brief, pages 10-11.

The critical issue before us is whether the examiner is correct in concluding that Faour's coating layer (8) is the same as appellant's membrane (1). Answer, page 4. We find that the examiner is incorrect for the following reasons.

We note that during patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed.Cir. 1989). In determining the patentability of claims, the PTO gives claim language its "broadest reasonable interpretation" consistent with the specification and claims. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (citations omitted).

In the instant case, claim 1 recites "[a] main compartment confined by a pharmaceutically acceptable membrane". The word "membrane" is defined as "a thin soft pliable sheet or layer esp. of animal or plant origin". See Merriam-Webster's Collegiate Dictionary, 10th Edition (2000), pg. 723. Appellant's specification, on page 4, also sets forth examples of suitable membranes. The examiner fails to adequately explain how Faour's coating (8), which is described in Faour's Abstract as "a final finish coat", can be a membrane. We have carefully reviewed the entire disclosure of Faour and also cannot find how final finish coat (8) can be a membrane. Because of this failing made by the examiner, we agree with appellant's arguments, and determine that the examiner has not set forth a prima facie case of anticipation or obviousness.

We therefore reverse each of the rejections.

REVERSED

TONI R.SCHEINER Administrative Patent Judge	)	
DEMETRA J. MILLS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
BEVERLY A. PAWLIKOWSKI Administrative Patent Judge	)	

BAP/vsh

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